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PATENT

Attorney Docket No.: 23091/25

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Steinberg et al. EXAMINER: TBD  
SERIAL NO.: 10/076,858 GROUP ART UNIT: TBD  
FILED: 02/14/2002  
FOR: MICROMACHINED STRUCTURES MADE BY COMBINED WET AND DRY ETCHING

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service via Express Mail, No. EV 128906305 US on the date shown below with sufficient postage in an envelope addressed to: BOX MISSING PARTS, Assistant Commissioner for Patents, Washington, DC 20231 on:

By: Maria Eliseeva  
Maria Eliseeva

Date: August 13, 2002

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PETITION UNDER RULE 37 CFR 1.47**OFFICE OF PETITIONS**

Dear Sir:

The below signed attorney for the applicant hereby sets forth the following facts to support the filing of the above-identified application without the signature on the declaration of one of the inventors. This petition is being submitted together with a response to Notice of Missing Parts dated 03/13/2002, filed herewith.

To the best of my information and belief of the pertinent facts, one of the co-inventors, Dan. A Steinberg, refuses to sign the declaration. Three other co-inventors have signed the declaration.

On information and belief, the following are the pertinent facts (listed as 1 through 7):

1. The company where all the inventors were/are employed (Haleos Inc.) is in Chapter 11 bankruptcy proceeding. Mr. Sherrer told me on the phone about two weeks ago that he attempted to reach Mr. Steinberg personally, Mr. Steinberg was asked to sign the application, and that Mr. Steinberg refused to sign the application. Mr. Sherrer told me that Mr. Steinberg also gave the same answer regarding other pending applications where he is listed as an inventor. I attach to this declaration an e-mail from Mr. Sherrer with a detailed description of his communication with Mr. Steinberg regarding this and other pending patent cases.

2. I spoke with Mr. Sherrer on the phone yesterday and today, he told me that due to the company's current financial situation the company was shut down during the last two weeks (weeks of August 5<sup>th</sup> and July 29<sup>th</sup> of 2002), which made it close to impossible to pursue this matter further during the last two weeks.

3. Mr. Steinberg is a registered patent agent (Reg. No. 45129, 410 Lee Street, Blacksburg VA USA 24060, the address listed in the PTO's roster of attorneys and agents), who is certainly aware of the application, its contents and the importance of the inventor's signature.

4. Today is the last day to file the response to Notice of Missing Parts in the above-referenced application within the 3-month extension period.

5. During years 2000, 2001, and 2002 the company filed more than 100 patent applications. Due to the Chapter 11 bankruptcy proceedings, Mr. Sherrer's company could not keep a number of applications pending, so they went abandoned. The company tries to maintain as many applications covering its valuable technology pending as possible and, hopefully, have them examined and later issued as patents.

6. My firm was asked to assist Haleos Inc./ACT MicroDevices in the task of keeping the pending applications alive, receiving the final authorization to proceed about 3 weeks ago. We are trying to save numerous applications with impending bar dates/expiring statutory periods, and while the best possible efforts to preserve the patent portfolio have been made, the company's shut down has made it close to impossible to obtain documents pertinent to the pending cases.

7. As stated by Mr. Sherrer, all inventors are under the obligation to assign the invention to Haleos.

The applicants will be irreparably damaged by the loss of benefit of the application due to Mr. Steinberg's refusal to sign the declaration. Due to the impending expiration of the statutory period of pendency of the above-referenced application and the current Chapter 11 proceedings, yet another application protecting the technology which is the claimed subject matter of the above-identified application may go abandoned.

If any additional information is required in connection with this petition, please contact the undersigned. Please charge the fee due with this petition to our deposit account 500369.

Respectfully submitted by:



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Date: Aug. 13, 2002

Enclosed: Facts pertinent to this petition as communicated by David Sherrer, co-inventor and President of Haleos Inc. /ACT MicroDevices Inc.

**Eliseeva, Maria M.**

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**From:** David W. Sherrer [dsherrer@haleos.com]  
**Sent:** Tuesday, August 13, 2002 5:03 PM  
**To:** Eliseeva, Maria M.  
**Subject:** Hostile Inventor

Maria,

Dan Steinberg has stated to numerous persons including myself, our CTO Mino Dautartas, and others here that he will not sign the declarations. I attempted formally to contact him via phone on 7/19 but was unable to get anything but a fax tone from his only known phone number. I thus faxed the declaration with a request to sign and fax back to our fax number. Dan, being our in-house patent agent, is well aware of all the cases and the procedures. Dan also is fully aware he signed a patent assignment agreement when he joined the company.

Unfortunately, Dan is one of the only hostile employees we have. There was no response from him regarding the fax until several days later. Dan stated word for word "I am not going sign this assignment." I have this as a voice mail archived on my phone. Dan has stated that there may be certain terms that could be negotiated, however we are not in a position to make this happen.

Please let me know if there is anything else I need to document regarding this issue.

Thanks,

David

8/13/2002